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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,212	02/18/2000	Seiji Yamashita	P 00 572.006	8199

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EXAMINER

TRAN, THAO T

ART UNIT	PAPER NUMBER
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1741

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DATE MAILED: 06/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-X

Office Action Summary

Application No.

09/507,212

Applicant(s)

YAMASHITA, SEIJI

Examiner

Thao T. Tran

Art Unit

1741

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 14-18, 20, 21, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13, 19, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 8, 2002 has been entered.
2. Claims 1-25 are currently pending in this application. Claims 19-25 have been newly added.
3. Claims 1-9, 14-18, 20-21, and 24-25 have been withdrawn from consideration as being directed to a non-elected invention as set forth in Paper No. 4.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-9, ~~14~~14-18, 20-21, and 24-25 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Claims 10-13, 19, and 22-23 have been elected by original presentation in Paper No. 4, and therefore, are being examined below.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 10-13, 19, and 22-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 10 contains the limitation “the titanium dioxide is not substantially prevented from attracting atmospheric water molecules for loosening particle contamination” that is considered as new matter, because there is no support anywhere in the specification for this limitation. In fact, on page 4 of the specification, Applicant discloses, “titanium dioxide provides a hydrophilic coating” (first line, last paragraph). Whereas the limitation “not substantially prevented from attracting atmospheric water molecules” appears to emphasize that the titanium dioxide is hydrophobic, hence negating the hydrophilic property of the titanium dioxide as disclosed in the specification.

Claim 22 contains the limitation “said coating includes substantially no additional active ingredients” that is considered as new matter, because there is no support anywhere in the specification for this limitation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10-13, 19, and 22-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10 and 22 are indefinite because the instant specification fails to provide a standard for measuring the degree of closeness or proximity of the wording “substantially”. See *In Seattle Box Co. v. Industrial Crating & Packing*, 731 F.2d 818, 826, 221 USPQ 568, 573-574 (Fed. Cir. 1984).

Claim 22 is further indefinite because of “substantially no additional active ingredients”. This limitation is a negative limitation without any specific additional active ingredients.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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10. Claims 10-13, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Goto et al. (US Pat. 6,235,358).

In regards to claim 10, Goto teaches an apparatus for reducing contamination (sanitary characteristics), comprising a plastic container (see plastic packaging container, col. 13, ln. 12), and a coating on selected portions of the container, wherein the coating consists essentially of titanium dioxide (see abstract; col. 3, ln. 12-41; col. 7, ln. 2-6; col. 13, ln. 12-15). The examiner is interpreting that selected portions of the container being the container.

With respect to the preamble “for reducing particle contamination of an article” and limitation “adapted for holding the article”; it has been within the skill in the art that an intended use clause in the preamble would have very little significant patentable weight in a method or apparatus claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967); *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951). Moreover, the limitation “adapted for holding the article” is not a positive limitation. In addition, since the prior art teaches a plastic container, a container should be able to hold an article; and since the prior art’s container is also coated with titanium dioxide, the prior art’s container should be able to perform the same function as that in the instant claim.

Furthermore, with respect to the limitation, “such that the titanium dioxide is not substantially prevented from attracting atmospheric water molecules for loosening particle contamination, for facilitating cleaning the container to prevent contamination of the article when the article is stored in the container”; it has been well settled that limitations on the properties of the material worked upon or functional limitations have been held to have insignificant patentable weight in an apparatus claim. See *In re Young*, 75 F.2d 966, 25 USPQ 69 (CCPA 1935); *In re Casey*, 152 USPQ 235 (CCPA 1967); *In re Danley*, 120 USPQ 528, 531

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(CCPA 1959); *Hewlett-Packard Co. V. Bausch & Lomb, Inc.*, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

In regards to claim 11, Goto teaches the container including a closeable lid for sealing the interior of the container from the external atmosphere (plastic can) (see col. 10, ln. 15-53, col. 13, ln. 13-14).

In regards to claims 12-13, Goto teaches the container including polypropylene and polycarbonate (see col. 13, ln. 29-35).

In regards to claims 22-23, Goto teaches the coating including substantially no additional active ingredients and that Goto teaches the coating comprising a gel (paint) (see col. 15, ln. 49-54; Table 1). The examiner is interpreting that Goto's composition containing an epoxy resin, a reactive diluent, an initiator, and titanium dioxide as a composition including substantially no additional active ingredients further than what is disclosed by the reference.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goto as applied to claim 10 above, and further in view of Nyseth (US Pat. 5,575,394).

Goto is as set forth in claim 10 above and incorporated herein.

Goto differs from the instant invention because the reference does not teach at least one semiconductor wafer disposed in the container. However, the reference further teaches that the thickness of the can bottom portions differs depending upon the use of the container (see col. 11, ln. 21-24), indicating that the container would be used for different purposes.

Nyseth teaches the use of a plastic container storing semiconductor wafers, hence including semiconductor wafers in the container (see abstract; col. 1, ln. 26-31).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have used a plastic container of Goto to store semiconductor wafers as taught by Nyseth, because Nyseth teaches that the use of a plastic container would minimize the likelihood of contamination of the wafers with particulate contaminants (see col. 1, ln. 26-31).

Response to Arguments

13. Applicant's arguments filed April 8, 2002 have been fully considered but they are not persuasive.

In response to applicant's request on the withdrawal of the Restriction Requirement, since this application contains claims 1-9, 14-18, 20, and 24-25 which are drawn to an invention nonelected with traverse in Paper No. 4, and since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-9, 14-18, 20-21, and 24-25 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Contact Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thao T. Tran whose telephone number is 703-306-5698. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. - 5:00 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 703-308-3322. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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June 16, 2002


NAM NGUYEN
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